

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. Claims 1-36 have been rejected. Claims 1-12, 15-17, and 26-27 have been amended. No new matter has been added. Accordingly, Claims 1-36 will be pending in the present application upon entry of this Amendment and Reply.

Claims 2, 4-12, 16, and 27 have been amended to correct typographical errors included therein and/or to make the language therein consistent with claims from which they depend.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

Claim Rejections – 35 U.S.C. § 112

On page 2 of the Office Action, Claim 16 was rejected under 35 U.S.C. § 112 ¶ 1 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 has been amended to depend from Claim 15. The Applicant submits that Claim 15 provides antecedent basis for the phrase “the strike layer,” and that the rejection of Claim 16 has thus been overcome.

Claim Rejections – 35 U.S.C. § 102

1. Claims 1-36 (Schulz et al. or Seiko'328)

On page 2 of the Office Action, the Examiner rejected Claims 1-36 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,510,012 to Schulz et al. or Japanese Patent JP 03-166328 (“Seiko '328”).

Claim 1 is in independent form and recites an “article having a decorative coating provided thereon” comprising, in combination with other elements, a “material” that “consists

essentially of pure scandium or scandium alloyed with one or more elements selected from the group consisting of oxygen, nitrogen, carbon, refractory metals, rare earth metals in the lanthanide series of the periodic table, transition metals, and combinations thereof.”

Neither Schulz et al. nor Seiko ‘328 identically discloses a “material” that “consists essentially of pure scandium or scandium alloyed with one or more elements selected from the group consisting of oxygen, nitrogen, carbon, refractory metals, rare earth metals in the lanthanide series of the periodic table, transition metals, and combinations thereof” as recited in independent Claim 1.

For example, Schulz et al. relates to an “alloy of gold” and Seiko ‘328 relates to a “hard-facing gold alloy.” Gold is not an element that is included in the Markush group recited in Claim 1. Accordingly, Claim 1 (and its associated dependent claims) is patentable over both Schulz et al. and Seiko ‘328.

Claim 17 is in independent form and recites an “article having a decorative coating” comprising, in combination with other elements, a “compound consisting essentially of scandium and one or more materials selected from the group consisting of oxygen, nitrogen, carbon, zirconium, titanium, yttrium, niobium, hafnium, molybdenum, chromium, aluminum, lanthanum, neodymium, praseodymium, samarium, dysprosium, erbium, ytterbium, and cerium.”

Neither Schulz et al. nor Seiko ‘328 identically discloses a “compound consisting essentially of scandium and one or more materials selected from the group consisting of oxygen, nitrogen, carbon, zirconium, titanium, yttrium, niobium, hafnium, molybdenum, chromium, aluminum, lanthanum, neodymium, praseodymium, samarium, dysprosium, erbium, ytterbium, and cerium” as recited in independent Claim 17. Accordingly, Claim 17 (and its associated dependent claims) is patentable over both Schulz et al. and Seiko ‘328.

Claim 26 is in independent form and recites an “article of manufacture” comprising, in combination with other elements, a “compound consisting essentially of scandium and at least one additional element deposited on the surface, the compound configured to provide a decorative color coating for the article; wherein the at least one additional element is selected

from the group consisting of nitrogen, oxygen, carbon, zirconium, titanium, yttrium, niobium, hafnium, molybdenum, chromium, aluminum, lanthanum, neodymium, praseodymium, samarium, dysprosium, erbium, ytterbium, and cerium.”

Neither Schulz et al. nor Seiko ‘328 identically discloses a “compound consisting essentially of scandium and at least one additional element deposited on the surface, the compound configured to provide a decorative color coating for the article; wherein the at least one additional element is selected from the group consisting of nitrogen, oxygen, carbon, zirconium, titanium, yttrium, niobium, hafnium, molybdenum, chromium, aluminum, lanthanum, neodymium, praseodymium, samarium, dysprosium, erbium, ytterbium, and cerium” as recited in independent Claim 26. Accordingly, Claim 26 (and its associated dependent claims) is patentable over both Schulz et al. and Seiko ‘328.

Claims 3 and 15 have been rewritten in independent form. The Applicant also submits that Claims 3 and 15 are allowable over both Schulz et al. and Seiko ‘328.

Claim 3 recites an “article having a decorative coating provided thereon” comprising, in combination with other elements, a “a material comprising scandium provided over at least a portion of the surface to thereby form a decorative coating which exhibits a desired color; wherein the material comprising scandium further comprises at least one of carbon and oxygen.”

Neither Schulz et al. nor Seiko ‘328 identically discloses a “a material comprising scandium provided over at least a portion of the surface to thereby form a decorative coating which exhibits a desired color; wherein the material comprising scandium further comprises at least one of carbon and oxygen” as recited in independent Claim 3. For example, Schulz et al. discloses an “alloy of gold and at least one element chosen from the group made up of titanium, vanadium, chromium, scandium, zirconium, niobium, molybdenum, hafnium, tantalum, and tungsten” (col. 1, lines 50-55), with no mention of carbon or oxygen. Seiko ‘328 also does not include in its abstract any mention of carbon or oxygen.

Accordingly, Claim 3 is patentable over both Schulz et al. and Seiko ‘328.

Claim 15 recites an “article having a decorative coating provided thereon” comprising, in combination with other elements, a “strike layer provided intermediate the substrate and the material comprising scandium.” Claim 16 depends from independent Claim 15.

Neither Schulz et al. nor Seiko ‘328 identically discloses a “strike layer” as recited in independent Claim 15. Accordingly, Claim 15 (and its associated dependent Claim 16) is patentable over both Schulz et al. and Seiko ‘328.

The Applicants respectfully request withdrawal of the rejection of Claims 1-36 under 35 U.S.C. § 102(b).

2. Claims 1, 4-8, 10-15, 17-20, 22-23, 25-31, 33, and 35-36 (Seiko’232 or ‘233)

On page 2 of the Office Action, the Examiner rejected Claims 1, 4-8, 10-15, 17-20, 22-23, 25-31, 33, and 35-36 under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent JP 03-188233 (“Seiko ‘233”) or Japanese Patent JP 03-188232 (“Seiko ‘232”).

Claim 1 is in independent form and recites an “article having a decorative coating provided thereon” comprising, in combination with other elements, a “material” that “consists essentially of pure scandium or scandium alloyed with one or more elements selected from the group consisting of oxygen, nitrogen, carbon, refractory metals, rare earth metals in the lanthanide series of the periodic table, transition metals, and combinations thereof.”

Neither Seiko ‘233 nor Seiko ‘232 identically discloses a “material” that “consists essentially of pure scandium or scandium alloyed with one or more elements selected from the group consisting of oxygen, nitrogen, carbon, refractory metals, rare earth metals in the lanthanide series of the periodic table, transition metals, and combinations thereof” as recited in independent Claim 1.

For example, Seiko ‘233 relates to a “silver alloy” and Seiko ‘232 relates to a “palladium alloy.” Neither silver nor palladium are elements that are included in the Markush group recited in Claim 1. Accordingly, Claim 1 (and its associated dependent claims) is patentable over both Seiko ‘233 and Seiko ‘232.

Claim 17 is in independent form and recites an “article having a decorative coating” comprising, in combination with other elements, a “compound consisting essentially of scandium and one or more materials selected from the group consisting of oxygen, nitrogen, carbon, zirconium, titanium, yttrium, niobium, hafnium, molybdenum, chromium, aluminum, lanthanum, neodymium, praseodymium, samarium, dysprosium, erbium, ytterbium, and cerium.”

Neither Seiko '233 nor Seiko '232 identically discloses a “compound consisting essentially of scandium and one or more materials selected from the group consisting of oxygen, nitrogen, carbon, zirconium, titanium, yttrium, niobium, hafnium, molybdenum, chromium, aluminum, lanthanum, neodymium, praseodymium, samarium, dysprosium, erbium, ytterbium, and cerium” as recited in independent Claim 17. Accordingly, Claim 17 (and its associated dependent claims) is patentable over both Seiko '233 and Seiko '232.

Claim 26 is in independent form and recites an “article of manufacture” comprising, in combination with other elements, a “compound consisting essentially of scandium and at least one additional element deposited on the surface, the compound configured to provide a decorative color coating for the article; wherein the at least one additional element is selected from the group consisting of nitrogen, oxygen, carbon, zirconium, titanium, yttrium, niobium, hafnium, molybdenum, chromium, aluminum, lanthanum, neodymium, praseodymium, samarium, dysprosium, erbium, ytterbium, and cerium.”

Neither Seiko '233 nor Seiko '232 identically discloses a “compound consisting essentially of scandium and at least one additional element deposited on the surface, the compound configured to provide a decorative color coating for the article; wherein the at least one additional element is selected from the group consisting of nitrogen, oxygen, carbon, zirconium, titanium, yttrium, niobium, hafnium, molybdenum, chromium, aluminum, lanthanum, neodymium, praseodymium, samarium, dysprosium, erbium, ytterbium, and cerium” as recited in independent Claim 26. Accordingly, Claim 26 (and its associated dependent claims) is patentable over both Seiko '233 and Seiko '232.

Claim 15 has been rewritten in independent form. The Applicant also submits that Claim 15 (and its dependent Claim 16) is allowable over both Seiko '233 and Seiko '232.

Claim 15 recites an “article having a decorative coating provided thereon” comprising, in combination with other elements, a “strike layer provided intermediate the substrate and the material comprising scandium.” Claim 16 depends from independent Claim 15.

Neither Seiko '233 nor Seiko '232 identically discloses a “strike layer” as recited in independent Claim 15. Accordingly, Claim 15 (and its associated dependent Claim 16) is patentable over both Seiko '233 and Seiko '232.

The Applicants respectfully request withdrawal of the rejection of Claims 1, 4-8, 10-15, 17-20, 22-23, 25-31, 33, and 35-36 under 35 U.S.C. § 102(b).

* * *

It is submitted that each outstanding objection and rejection to the Application has been overcome, and that the Application is in a condition for allowance. The Applicants request consideration and allowance of all pending claims.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Atty. Dkt. No. 081149-0109

Please direct all correspondence to the undersigned attorney or agent at the address indicated below.

Respectfully submitted,

Date 4/24/2006

By 

FOLEY & LARDNER LLP
Customer Number: 26371
Telephone: (313) 234-7150
Facsimile: (313) 234-2800

Marcus W. Sprow
Attorney for Applicant
Registration No. 48,580